REMARKS

Applicants acknowledge receipt of the Final Office Action mailed October 14, 2009.

In the Final Office Action, the Examiner rejected claims 1-3, 5-12, 14-19, and 22 under 35 U.S.C. § 103(a) as being unpatentable over *Maeda et al.* (U.S. Patent No. 6,785,487) ("*Maeda '487*") in view of *Maeda et al.* (U.S. Patent No. 6,567,627) ("*Maeda '627*"); and rejected claims 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Maeda '487* in view of *Maeda '627*, and further in view of *Funaki* (U.S. Patent No. 6,707,471).

In this Amendment, Applicants amend claims 1 and 12. Claims 1-3, 5-12, and 14-22 remain pending. Of these claims, claims 1 and 12 are independent.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to claims 1 and 12. No new matter has been introduced.

Based on the foregoing amendments, Applicants traverse the rejections above and respectfully request reconsideration for at least the reasons that follow.

I. 35 U.S.C. § 103(a) REJECTIONS

Applicants traverse the rejection of claims 1-3, 5-12, 14-19, and 22 under 35 U.S.C. § 103(a) as being unpatentable over *Maeda '487* in view of *Maeda '627*. Applicants respectfully disagree with the Examiner's arguments and conclusions and submit that amended independent claims 1 and 12 are patentably distinguishable over *Maeda '487* and *Maeda '627* at least for the reasons described below.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. *See*

M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. *See* id. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Amended independent claim 1, and similarly amended independent claim 12, recites an image forming apparatus, comprising: "a setting screen for receiving an input of setting an image forming condition, . . . wherein the setting screen includes a multi-function OK button for enabling the setting of the image forming condition inputted on

the setting screen, the multi-function OK button being configured to perform at least two functions when the multi-function OK button receives an input, the at least two functions including enabling the inputted setting of the image forming condition and creating and displaying a shortcut button on the initial screen for redisplaying the setting screen on which the image forming condition was set" (emphasis added).

Maeda '487 appears to disclose an image forming device arranged such that desired functions and their respective setting details can be allocated to shortcut keys, and titles and icons representing the functions allocated to the shortcut keys can also be designated for the shortcut keys and displayed on the shortcut keys. Accordingly, when executing a function allocated to a shortcut key, the operator can select the desired function according to the indication on the shortcut key without having to refer to the operations manual or the like. (*Maeda '487*, Abstract).

As admitted by the Examiner, *Maeda '487*, however, fails to teach or suggest at least "the setting screen includes a multi[-]function OK button for enabling the setting of the image forming condition inputted on the setting screen, the multi-function OK button being configured to perform at least two functions when the multi-function OK button receives an input, the at lest two functions including enabling the inputted setting of the image forming condition and creating and displaying a shortcut button for redisplaying the setting screen on which the image forming condition was set." (*Final Office Action*, pp. 2-3, para. 2). *Maeda '487* also fails to disclose at least "creating and displaying a shortcut button on the initial screen for redisplaying the setting screen on which the image forming condition was set," as recited in amended independent claim 1, and similarly amended independent claim 12 (emphasis added).

In order to cure the deficiencies of *Maeda '487*, the Examiner relies on *Maeda '627* and alleges "Maeda ('627) discloses . . . [an] apparatus and method for an image forming condition displaying method that . . . discloses a 'close' key that completes the allocation of functions with the settings of function key being 2 in 1, left staple, and dotted line. These settings are confirmed with the creation of a 2 in 1 shortcut (K2) in Figure 16. After selecting the 2 in 1 shortcut, the setting screen 62 is redisplayed." (*Final Office Action*, p. 3, ll. 5-10). Such teaching, even if present in *Maeda '627*, however, does not constitute or suggest at least "creating and displaying a shortcut button on the initial screen for redisplaying the setting screen on which the image forming condition was set," as recited in amended independent claim 1, and similarly amended independent claim 12 (emphasis added).

Maeda '627 discloses that "[a]s with screen 62' of FIG. 4, when the 'shortcut key registration' key B10 is pressed after the respective functions have been set to desired settings, as shown in FIG. 6, the screen is switched to a shortcut key selection screen 8 for selecting the shortcut key to which the aforementioned setting are allocated" (emphasis added). (*Maeda '627*, col. 6, ll. 30-35). Accordingly, in *Maeda '627* a user shifts to a different screen after function setting, selects the shortcut key for function allocation/registration, and then depresses the close button. *Maeda '627*, however, fails to disclose wherein the function setting and the shortcut key registration are both performed on the initial screen.

Furthermore, the "close" key B12 of *Maeda '627* is a button for merely inputting a name or name selection. The function of the "close" key B12 is entirely different than that of the claimed multi-function OK button. Specifically, according to the present

invention, when the image forming condition is set and the multi-function OK button is depressed, the set image forming condition is enabled, and at the same time, the shortcut button for redisplaying the setting screen is automatically created.

As explained above, the elements of independent claims 1 and 12 are neither taught nor suggested by the cited references. Consequently, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claim. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claims 1 and 12. Claims 1 and 12, and claims 2, 3, 5-11, 14-19, and 22 which depend therefrom, are patentable over *Maeda '487* and *Maeda '627*. Applicants therefore request that the rejection of claims 1-3, 5-12, 14-19, and 22 under 35 U.S.C. § 103(a) be withdrawn.

Applicants traverse the rejection of claims 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Maeda '487* in view of *Maeda '627*, and further in view of *Funaki*. The deficiencies of *Maeda '487* and *Maeda '627* are discussed above.

With respect to *Funaki*, the Examiner alleges "Funaki discloses . . . [an] apparatus and method for an image forming condition displaying method that . . . discloses a cancel button for specifying the cancellation of processing of entered data . . ." (*Final Office Action*, p. 10, ll. 9-11). Such teaching, even if present in *Funaki*, however, does not constitute or suggest at least an image forming apparatus, comprising: "a setting screen for receiving an input of setting an image forming

condition, . . . wherein the setting screen includes a multi-function OK button for enabling the setting of the image forming condition inputted on the setting screen, the multi-function OK button being configured to perform at least two functions when the multi-function OK button receives an input, the at least two functions including enabling the inputted setting of the image forming condition and creating and displaying a shortcut button on the initial screen for redisplaying the setting screen on which the image forming condition was set" (emphasis added), as recited in amended independent claim 1, and similarly amended independent claim 12.

Claims 20 and 21 correspondingly depend from independent claims 1 and 12 and require all elements thereof. As explained above, the elements of independent claims 1 and 12 are neither taught nor suggested by the cited references. Consequently, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claims. Accordingly, no reason has been clearly articulated as to why the claims would have been obvious to one of ordinary skill in view of the prior art and a *prima facie* case of obviousness has not been established for claims 20 and 21 at least due to their dependence. Therefore, Applicants request that the rejection of claims 20 and 21 under 35 U.S.C. § 103(a) be withdrawn.

II. CONCLUSION

Applicants respectfully submit that claims 1-3, 5-12, and 14-22 are in condition for allowance.

The Final Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise,

Applicants decline to subscribe to any statement or characterization in the Final Office Action.

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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